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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/963,489 | 09/27/2001 | Tetsuji Fuwa | 110732 | 9315 |

25944 7590 02/28/2005

OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

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| EXAMINER |
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O'CONNOR, GERALD J

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| ART UNIT | PAPER NUMBER |
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3627

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/963,489

Applicant(s)

Fuwa

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on January 10, 2005 (Response to Req't for Restriction).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 10-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on September 27, 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20020425.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restriction

1. Applicant's election without traverse of the invention of Group I, claims 1-9, in the reply filed January 10, 2005 is hereby acknowledged.

2. Claims 10-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed January 10, 2005.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e)¹ the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national

¹ The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) apply to the examination of this application as the application being examined was (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) as amended by the AIPA (post-AIPA 35 U.S.C. 102(e)).

application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1-4 and 6-9 are rejected under 35 U.S.C. 102(e) as being anticipated by von Rosen et al. (US 6,493,677).

Von Rosen et al. disclose a method for selling, over a transmission network, unique information indicating products that indicate unique information, the method comprising: receiving, at a server, unique information supplied from a client device across the transmission network to the server; preparing, based on unique information, a preview image of a unique information indicating product that indicates the unique information; transmitting the prepared preview image to the client device; and displaying the preview image using a browser of the client device.

Regarding claim 2, the steps of preparing and displaying of the method of von Rosen et al. are performed in real time response to character input performed at the client device for the unique information.

Regarding claim 3, the steps of preparing and displaying of the method of von Rosen et al. are performed in response to a preview reception request sent from the client device to the server.

Regarding claim 4, the step of displaying of the method of von Rosen et al. includes displaying, using the browser of the client device, a plurality of preview images corresponding to different colors selectable for the unique information indicating product.

Regarding claim 6, the step of displaying of the method of von Rosen et al. includes displaying, using the browser of the client device, a plurality of preview images corresponding to different sizes selectable for the unique information indicating product.

Regarding claim 7, the step of displaying of the method of von Rosen et al. includes displaying, using the browser of the client device, a plurality of preview images corresponding to different types selectable for the unique information indicating product.

Regarding claim 8, the step of receiving the unique information of the method of von Rosen et al. includes receiving a customer identifier; the step of preparing the preview image includes extracting, from a customer database that stores customer identifiers in correspondence with customer information, unique information associated with the customer identifier and preparing the preview image to indicate the extracted unique information on the unique information indicating product; and the step of displaying includes displaying the extracted unique information in the preview image of the unique information display product.

Regarding claim 9, the step of preparing of the method of von Rosen et al. includes preparing a customer identifier when the server receives unique information to be displayed on the unique information indicating product, but does not receive a customer identifier; and the step of transmitting the prepared preview image to the client device includes transmitting the prepared customer identifier.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over von Rosen et al.

Von Rosen et al. disclose a method for selling, over a transmission network, unique information indicating products that indicate unique information, as applied above in the rejection of claim 1 under 35 U.S.C. 102(e), but the method of von Rosen et al. does not explicitly include that the step of displaying includes displaying, using the browser of the client device, a plurality of preview images corresponding to different text fonts selectable for the unique information indicating product. However, displaying text in various fonts in order to vary the appearance of the text is certainly a well known, hence obvious, step to include in any method of customizing the appearance of graphical information containing text, and official notice to that effect is hereby taken. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of von Rosen et al. so as to include functionality to selectably display the text in different fonts, as is well known to do, in order to allow the customer to have greater control over the appearance of the product, and since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to the disclosure.
8. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(703) 305-1525**, and whose facsimile number is **(703) 746-3976**.

PLEASE TAKE NOTICE that on April 14, 2005 the examiner's telephone and facsimile numbers will be changing, to (571) 272-6787 and (571) 273-6787, respectively.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at (703) 308-5183, or, beginning April 14, 2005, at (571) 272-6788.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (not changing). Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

February 18, 2005

A handwritten signature in black ink, appearing to read "Gerald J. O'Connor", followed by the date "(2-18-05)" in parentheses.

Gerald J. O'Connor

Patent Examiner

Group Art Unit 3627